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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/024,585

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Errol O. Kendall

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EXAMINER

CHANDLER, SARA M

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

05/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/024,585	<b>Applicant(s)</b> KENDALL ET AL.	
	<b>Examiner</b> Sara Chandler	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02/12/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 44-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/25/04; 9/11/02; 7/29/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's election without traverse of claims 44-59 in the reply filed on 02/12/07 is acknowledged.

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the citizenship of each inventor.

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

Specifically, the residence and citizenship information for Sharyn R. Kohen is missing.

### ***Claim Interpretation***

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

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2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. See MPEP 2106 II C. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result (e.g., "for \_\_\_\_\_"); but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result (e.g., "for \_\_\_\_\_"), but does not result in a structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as "*if, may, might, can could*", as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as "*wherein, whereby*", that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a

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particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 44-59** are rejected under 35 U.S.C. 103(a) as being unpatentable over Libman, US Pat. No. 5,987,434 in view of

"Rate of Return on Differential Premiums for Selected Participating Life Insurance Contracts" by Phyllis Schiller Myers and S. Travis Pritchett. The Journal of Risk and Insurance, Vol. 50, No. 4. (Dec., 1983), pp. 569-586). (hereinafter Myers);

"The Rate of Return on Universal Life Insurance" by Antony C. Cherin and Robert C. Hutchins. The Journal of Risk and Insurance, Vol. 54, No. 4. (Dec., 1987), pp. 691-711. (hereinafter Cherin);

"Life Insurance Management Issues" by Stephen W. Forbes. The Journal of Risk and Insurance, Vol. 54, No. 3. (Sep. 1987), pp. 603-613. (hereinafter Forbes);

"Determinants of Universal Life Insurance Cash Values" by James M. Carson. The Journal of Risk and Insurance, Vol. 63, No. 4, Symposium on Catastrophic Risk. (Dec., 1996), pp. 673-681. (hereinafter Carson);

"Effects of Relationship Marketing on Satisfaction, Retention, and Prices in the Life Insurance Industry" by Lawrence A. Crosby and Nancy Stephens. Journal of Marketing Research, Vol. 24, No. 4 (Nov. 1987). (hereinafter Crosby);

"Classifying Financial Distress in the Life Insurance Industry," by Ran BarNiv and Robert A. Hershbarger. The Journal of Risk and Insurance, Vol. 57, No. 1. (Mar., 1990), pp. 110-136). (hereinafter BarNiv).

**Re Claims 44-51:** Libman discloses a method for appraising value of a life insurance product to a customer, comprising:

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determining a first numeric rating; a second numeric rating; a third numeric rating; a fourth numeric rating; a fifth numeric rating; and a sixth numeric rating (Libman, abstract, col. 1, line 1 – col. 4, line 42; col. 5, lines 45+ - col. 14, line 6).

weighting the first, second, third, fourth, fifth and sixth numeric ratings to determine an overall rating of value for the life insurance product (Libman, abstract, col. 1, line 1 – col. 4, line 42; col. 5, lines 45+ - col. 14, line 6).

Libman fails to explicitly disclose:

wherein the rating is of the benefits by a life insurance product offered to a customer at a proposed price;

wherein the rating is of the life insurance performance under predetermined assumptions about future interest rates and reduced premium levels;

wherein the rating is of a financial status of an insurance company providing the life insurance product;

wherein the rating is of the historical interest credited rates for the life insurance product;

wherein the rating is of the quality of customer service provided by the insurance company; and

wherein the rating is of the financial strength of the insurance company.

Myers discloses:

wherein the rating is of the benefits by a life insurance product offered to a customer at a proposed price (Myers, pgs. 569-586).

Cherin discloses:

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wherein the rating is of the life insurance performance under predetermined assumptions about future interest rates and reduced premium levels (Cherin, pgs. 691-711).

Forbes discloses:

wherein the rating is of a financial status of an insurance company providing the life insurance product (Forbes, pgs. 603 – 613).

Carson discloses:

wherein the rating is of the historical interest credited rates for the life insurance product (Carson, 673-681).

Crosby discloses:

wherein the rating is of the quality of customer service provided by the insurance company (Crosby, abstract, pg. 404).

BarNiv discloses:

wherein the rating is of the financial strength of the insurance company (BarNiv, pgs. 110-136).

Broadest Reasonable Interpretation: For purposes of claim interpretation the following terms have been given their broadest reasonable interpretation in accordance with MPEP § 2111.

value: a) an amount regarded as a fair equivalent for something or b) the relative, worth, merit or importance of something.

weight: a) authoritative influence or importance



It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Libman by adopting the teachings of Myers, Cherin, Forbes, Carson, Crosby and BarNiv to provide a method further comprising:

wherein the rating is of the benefits by a life insurance product offered to a customer at a proposed price;

wherein the rating is of the life insurance performance under predetermined assumptions about future interest rates and reduced premium levels;

wherein the rating is of a financial status of an insurance company providing the life insurance product;

wherein the rating is of the historical interest credited rates for the life insurance product;

wherein the rating is of the quality of customer service provided by the insurance company; and

wherein the rating is of the financial strength of the insurance company.

As suggested by Libman, one would have been motivated to improve the volume of transactions and sales by determining the 'best policy' providers and products for clients as determined by those providers and products that meet a specified set of criteria.

**Re Claims 52-59:** Libman discloses a method for appraising value of a life insurance product to a customer, comprising;

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determining a plurality of ratings (Libman, abstract, col. 1, line 1 – col. 4, line 42; col. 5, lines 45+ - col. 14, line 6);

weighting the plurality of ratings to determine an overall rating of value of the life insurance product (Libman, abstract, col. 1, line 1 – col. 4, line 42; col. 5, lines 45+ - col. 14, line 6).

Libman fails to explicitly disclose:

- a product value for money rating of a life insurance product;
- a product stress tolerance rating of the life insurance product;
- a management performance rating of a company offering the life insurance product;
- a historical interest credited rates rating of the life insurance product;
- a customer service quality rating of the company offering the life insurance product; and
- a financial strength rating of the company offering the life insurance product.

Myers discloses:

- a product value for money rating of a life insurance product (Myers, pgs. 569-586).

Cherin discloses:

- a product stress tolerance rating of the life insurance product (Cherin, pgs. 691-711).

Forbes discloses:

- a management performance rating of a company offering the life insurance product (Forbes, pgs. 603 – 613).

Carson discloses:

- a historical interest credited rates rating of the life insurance product (Carson, 673-681).

Crosby discloses:

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a customer service quality rating of the company offering the life insurance product (Crosby, abstract, pg. 404).

BarNiiv discloses:

a financial strength rating of the company offering the life insurance product (BarNiv, pgs. 110-136).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Libman by adopting the teachings of Myers, Cherin, Forbes, Carson, Crosby and BarNiv to provide a method further comprising:

a product value for money rating of a life insurance product;

a product stress tolerance rating of the life insurance product;

a management performance rating of a company offering the life insurance product;

a historical interest credited rates rating of the life insurance product;

a customer service quality rating of the company offering the life insurance product; and

a financial strength rating of the company offering the life insurance product.

Broadest Reasonable Interpretation: For purposes of claim interpretation the following terms have been given their broadest reasonable interpretation in accordance with MPEP § 2111.

value: a) an amount regarded as a fair equivalent for something or b) the relative, worth, merit or importance of something.

weight: a) authoritative influence or importance

As suggested by Libman, one would have been motivated to improve the volume of transactions and sales by determining the 'best policy' providers and products for clients as determined by those providers and products that meet a specified set of criteria.

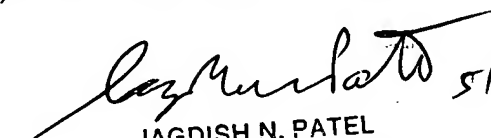
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC

  
JAGDISH N. PATEL  
PRIMARY EXAMINER